

February 15, 1999, and (2) Breeders' Rights Application No. 03100, which was filed in Israel on September 9, 1999.

The Examiner asserts that if the plant 'Penber' was publicly available (which it was in Europe), then the application(s), proposed denomination(s), or granted PBR certificate(s), combined with the knowledge in the prior art, would enable one of ordinary skill in the art to reproduce the claimed patent. This assertion appears to be the Examiner's alleged support for the 35 U.S.C. § 102(b) rejection. The assertion is simply not supported by any existing law and represents a policy that is inconsistent with past policy and the established principles of plant patent law.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987). See MPEP 2131. See also, *In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999). In fact, it is a foundation of patent practice that two or more references cannot be combined by an Examiner to assert an anticipation rejection. However, even if one assumes that the Examiner is using each reference singly as a basis for a § 102(b) rejection, Examiner's assertion still fails because foreign public use or sale of an invention is not prior art under § 102(b), nor is a non-enabling printed disclosure of the invention.

For argument sake, one must acknowledge that the Patent Office only permits the use of multiple references in a 35 U.S.C. § 102 rejection under three distinct circumstances/exceptions:

- A) to prove the primary references contain an "Enabled Disclosure";
- B) to explain the meaning of a term used in the Primary reference; or
- C) to show that a characteristic not disclosed in a reference is inherent.

See MPEP 2131.01

The Examiner combines Applicant's PBR application(s) for 'Penber', proposed denomination(s), and granted PBR certificate(s) with the existence of the plant anywhere in the world to assert a 35 U.S.C. § 102(b) rejection. Even if such references are proper prior art, such a combination to assert an anticipation rejection is improper under standard patent procedure because Examiner's combination of references does not fall within the exceptions listed above.

Withdrawal of the 35 U.S.C. § 102(b) rejection is respectfully requested.

Additionally, Applicant respectfully asserts additional arguments for withdrawal of Examiner's rejection of Applicant's plant patent application for 'Penber'.

First, to assert an anticipation rejection based on a prior art reference, in the prior art reference, "the identical invention must be shown in as complete detail as is contained in the...claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989). See MPEP 2131. In order to constitute an anticipation, a reference must be able to teach someone of ordinary skill in the art how to make and/or use an invention. "By the weight of authority, the description must enable such a person not only to comprehend the invention but also to make it." 1 Chisum on Patents § 3.04[1]. Meaning, that for a Plant Breeders' Right Certificate (or the like) to anticipate a plant patent application, the certificate must describe the plant in as much detail as the plant patent application which is expressly incorporated into the claim. That is not the case. A Plant Breeders' Rights Certificate does not contain the same type or same volume of information that a plant patent contains. In the pending case at hand, the PBR certificates cited by Examiner contain very scant information compared to the wealth of information given in the plant patent application. Because the certificate does not contain every element of the claimed plant 'Penber', nor could it enable someone skilled in the art to asexually reproduce the plant, the PBR certificate cannot serve as a rejection for a U.S. plant patent application.

Additionally, the landmark decision *In re LeGrice* illustrates that the enablement requirement for a prior publication in plant patent cases “must meet the same standards which must be met before a description in a printed publication becomes a bar in non-plant patent cases.” 301 F.2d at 944. The court of *LeGrice* held that the publication of descriptions and pictures of the ‘Rose Floribunda Plant’ in the National Rose Society Annual of England and in catalogues more than one year before filing United States plant patent applications should not be a bar to issuance of the patents. It should be noted that the plants in *In re LeGrice* also were available only in a foreign country, so the situation is identical as that set forth herein. *Id.* at 930. Thus, based on the above information, the minimal detail contained in the PBR certificates cannot be seen to enable the ‘Penber’ plant patent.

The Examiner’s reliance on *Ex parte Thomson*, 24 USPQ2d 1618 (Bd. of Pat. App. Int. 1992) is grossly misplaced. *Thomson* dealt with the rejection of a utility patent for a plant that is sexually reproduced by seeds and not a plant patent where the claim is specifically directed by statute to what is shown and described. The court was looking at the rejection from a utility patent standpoint and not a plant patent standpoint. The issue in *Thomson* was whether publications printed more than a year before the utility patent application describing the plant in question, as well as public availability of seeds of the plant, should bar issuance of the utility patent. *Id.* at 1619. In upholding the Examiner’s rejection, the court stated “we are convinced that the skilled cotton grower would have had the wherewithal, upon reading the publicly disseminated reference articles to purchase the commercially available Siokra seeds, and employ conventional techniques to plant and nurture the seeds to maturity in order to obtain the claimed invention.” *Id.* at 1620.

It strikes the undersigned as ludicrous to suggest that someone with only the knowledge of the plant and the Plant Breeders’ Rights Certificate could recreate the patented variety covered by the claim. One skilled in the art could not develop ‘Penber’ from the PBR

certificates. The plant was not available in the United States so it could not have been asexually reproduced in this country.

The Board, in *Thomson*, reasoned that by Applicant's reliance on seed deposit for its own enabling utility patent application disclosure, the Applicant also was constrained to admit that the availability of the seeds, prior to the Applicant's filing date, amounted to an enabling disclosure of the invention.

By contrast, the present plant application is distinguishable from *Thomson* in that plant patent applications are never substantiated with biological deposits in the first place, and moreover the present plant materials and cut flowers were not available to a skilled artisan in this country by any means. The importation and customs restrictions on cut flower and similar stock require not only quarantine but a lengthy stock cleaning up process before new cultivars are made available, if at all, to United States purchasers. (Only 10% of imported cultivars ever become commercially available). In *Thomson*, the Board highlighted that the Applicant had "proffered no objective evidence on [the] record that the claimed Siokra seeds were unavailable to the skilled artisan," whereas in the present application the availability of the plant stock was limited by law and as set forth in the foregoing Response Under 37 C.F.R. 1.105. *Id.* at 1620. Therefore, in the present application, cultivars were not available to a skilled artisan in the United States such that he/she could attain them and asexually reproduce the Plant Breeders' Rights registered cultivar prior to the filing of the above-identified patent application.

Thus, taking into account that Applicant is desirous of a plant patent for an asexually reproduced plant, along with the other aforementioned differences between *Thomson* and Applicant's situation, *Thomson* is not relevant.

The principles of *LeGrice* are easily applied to the subject application because factually both deal with roses.

In *LeGrice* the court stated at 301 F.2d 929, at p. 935:

Before passing to an analysis of the case law with respect to the meaning of "described in a printed publication," as this term is used in 35 U.S.C. § 102(b), it must be borne in mind that there are inherent differences between plants and manufactured articles. Should a plant variety become extinct one cannot deliberately produce a duplicate even though its ancestry and the techniques of cross-pollination be known. Manufactured articles, processes, and chemical compositions when disclosed are, however, susceptible to man-made duplication.

The court then goes on to explain why one cannot recreate a rose from a written description.

The record before the Patent Office in *LeGrice* identifies that the rose was available. The court stated:

While man can and does assist nature by the cross-pollination of selected parent plants, the actual creation of the new plant, because of the almost infinite number of possible combinations between the genes and chromosomes, is not presently subject to a controlled reproduction by act of man. While those skilled in this art now understand the mechanics of plant reproduction and the general principles of plant heredity, they are not presently able to control the factors which govern the combinations of genes and chromosomes required to produce a new plant having certain predetermined desired properties.

Id. at 938.

If the Patent Office is possessed of information that concludes otherwise, it should so state. Absent such information, one skilled in the art can know of the plant and look at the printed publication and still not produce the new rose plant with the certain predetermined desired properties. One needs access to the plant to asexually and identically reproduce the plant, which does not describe the case at hand.

Historically, the United States patent system granted protection to asexually reproduced plants via plant patents starting in 1930. Other countries, including Germany and

the Netherlands, implemented similar systems to provide incentives for plant breeders to create new varieties. The adoption of the 1961 Act of the International Convention for the Protection of New Varieties of Plants by a Diplomatic Conference in Paris on December 2, 1961 provided, for the first time, recognition of the rights of plant breeders on an international basis in UPOV member countries. This adoption was necessary because not all countries have patent-type protection for plants, or if they do, the likelihood, incredible expense, and value of obtaining a patent is a disincentive for plant breeders.

Hence, plant inventors usually seek protection for their new propagation first by Plant Breeders' Rights Certificates for reasons such as those eloquently elaborated in the landmark *LeGrice* decision. Judge Smith appropriately quoted Tennyson's "Flower in the Crannied Wall" to illustrate the difficulties and time that breeders have to endure before they can ascertain any patentable and profitable characteristics of their plant.

"Flower in the crannied wall,
I pluck you out of the crannies,
I hold you here, root and all, in my hand,
Little flower-but if you could understand
What you are, root and all, and all in all
I should know what God and Man is."

Id. at 938.

Thus, historically, a PBR Certificate is generally filed before a plant patent application to give a foreign breeder adequate protection while trialing and other testing takes place to see if the United States is a viable market. This symbiotic relationship between United States plant patent rights and international plant rights in UPOV member countries by way of PBR certificates has been maintained unharmed for close to four decades until the Patent Office has insisted on creating new statutory interpretation. Applicant respectfully asserts that the current Plant Patent Group has overlooked the spirit and sensitivity the world has bestowed upon the special nature of plant protection.

II. Disclosure

The Examiner objected to the disclosure under 35 C.F.R. § 1.163(a) and under 35 U.S.C. § 112, first paragraph. Further, the Examiner objected to the disclosure for the specific reasons noted in paragraphs A-Y of the detailed Office Action. First, Applicant respectfully submits that, as to paragraph G of the Office Action, Applicant acknowledges and has corrected undulated to undulated. As to paragraph X, Applicant verifies that the leaf color is 138A and the petal/petaloid color is 68C. As to the remaining paragraphs, namely A-F and H-W and Y, Applicant respectfully submits that the amendments to the specification overcome the Examiner's objections to the disclosure. Any additional information required is unavailable. Withdrawal of the objection to the disclosure is respectfully solicited. Finally, Applicant respectfully requests that the photographic illustration, filed March 19, 2001, should replace the originally filed photographic illustration, which should be cancelled.

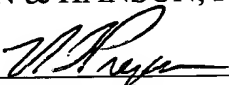
CONCLUSION

In view of the foregoing amendments and remarks, Applicant believes that the claim is patentable over the cited prior art and is in condition for allowance. Reconsideration of the rejection of the claim is respectfully requested.

Respectfully submitted,

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MARKED-UP COPY OF THE SPECIFICATION

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VARIETY OF GERANIUM PLANT NAMED 'PENBER'

BACKGROUND OF THE INVENTION

The present invention comprises a new and distinct cultivar of *Pelargonium x hortorum* known by the varietal name 'Penber'. The new variety was discovered in 1996 in a selective breeding program in Oosterhout, The Netherlands. The new variety is a naturally occurring mutation of 'Melody' (PEL 676). (U.S. Plant Patent No. 8,006.) The new variety exhibits the flower color of its parent, but differs in its flower shape, leaf color and leaf shape. The new variety was first asexually reproduced by vegetative propagation by cuttings in Dresden, Germany in 1997. The new variety has been trial and field tested and has been found to retain its distinctive characteristics and remain true to type through successive propagations.

DESCRIPTION OF THE DRAWING

The accompanying photographic drawing illustrates the new variety, with the color being as nearly true as is possible with color illustrations of this type.

DESCRIPTION OF THE PLANT

The following detailed description sets forth the characteristics of the new cultivar at an age of 6 months, grown in a pot having a 15 cm diameter. The data which defines these characteristics were collected by asexual reproductions by cuttings carried out in Dresden, Germany. The color readings were taken outdoors in shadow during summer. Color references are primarily to the R.H.S. Colour Chart of The Royal Horticultural Society of London.

PLANT

Classification:

Botanical: *Pelargonium x hortorum*.

Commercial: Zonal geranium.

Form: Erect.

Height from media surface to top of foliage: 22-25 cm.

Height from media surface to top of umbel: 30 cm.

Width: 25 cm.

Growth: Erect, very compact, well-branched.

Strength: Does not require artificial support.

Response time: 4 weeks.

Leaves:

Size: 6-8 cm long.

Width: 6.5 cm.

Shape: Cordate, [ondulated.] undulated.

Margin: Partially toothed.

Texture: Smooth.

Color: [Green Group 138A with edges of Green-White Group 157D.]
Upper surface has middle of Green Group 138A with an edge of Green-White Group 157D.
Lower surface has middle of Green Group 138B with an edge of Green-White Group 157D.

[Rib and veins:

Color: Darker than leaf surface.]

Rib color: Green Group 138C.

Vein color: Green Group 138C.

Petioles:

Color: [Medium green.] Green Group 138B

Diameter: 0.2 cm.

Length: 4 cm.

Stem/branches:

Color: [Medium Green.] Green Group 138B.

Length: 25 cm.

Internode length: 1-2 cm.

THE BUD

Shape when just showing color:

Overall: Semi-spherical

Individual bud: Narrow; elliptical.

Color: Green Group 143C.

Size when just showing color:

Umbel: 5 cm across.
Individual bud: 1 cm long; 0.5-0.8 cm wide.

INFLORESCENCE

Blooming habit: Semi-double.
Size of fully open bloom: 2-2.5 cm across.
Borne: [Flowers on u]Umbel; umbel on pedicel; pedicel on peduncle.

Umbel:

Diameter: 5 cm.
Depth: 4 cm.
Inflorescences: 50 per plant per season.

Flowers:

Form: Zygomorph.
Number of petals: 7-10.
Size: 1 cm across; 1-1.5 cm long.
Petals:

Apex: Round.
Base: Pointed.
Margin: Smooth.

Color:

Markings/dots: Red-Purple Group 57B
Upper surface: Red-Purple Group 68C.
Lower surface: Red-Purple Groups 67C-D.

Texture and appearance: Velvety.

Sepals:

Quantity: 5.
Length: 0.7 cm.
Width: 0.3 cm.
Margin: Smooth.
Upper surface color: Yellow-Green Group 144B.

Lower surface color: Yellow-Green Group 144B.

Petaloids:

Quantity: 7.

Shape: [Flakes; undulated.] Small, irregularly formed; undulated.

Apex: Round, but irregular.

Base: Pointed.

Margin: Smooth.

Width: 0.3 cm.

Color:

Upper surface: Red-Purple Group 68B.

Lower surface: Red-Purple Groups 67 C-D.

Pedicel:

Length: 2 cm.

Color: [Medium green.] Greyed-Orange Group 166B.

Peduncle:

Length: 5-8 cm.

Color: [Medium green.] Green Group 138B.

Disease/pest resistance: No [unusual] susceptibility to diseases or pests has been noted to date.

Lasting Quality: Long-lasting; 3 weeks per umbel.

REPRODUCTIVE ORGANS

Stamens:

Anthers: 3 mm long.

Filaments:

Length: 0.5 cm maximum.

Color: Pink.

Pollen: Yellow.

Pistils:

Number: [Five.] One with five parts.

Length: 0.3-0.4 cm.

Stigma: Pink.

Style: 0.8 cm long.

Ovaries:

Color: Greenish.

Length: 0.4 cm.

Fruit: Absent.

GENERAL CHARACTERISTICS

1. Very compact.
2. Very decorative as pot plant.
3. Chimeric plant with two-colored foliage.
4. Flowering season is spring until frost.

MARKED-UP COPY OF THE ABSTRACT

VARIETY OF GERANIUM PLANT NAMED 'PENBER'

ABSTRACT OF THE DISCLOSURE

A new and distinct zonal geranium plant with intense pink colored flowers above two-colored medium green foliage. The plant [flower] is suitable for pot planting.